ESTTA Tracking number:

ESTTA666808 04/15/2015

Filing date:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Yogitoes, LLC			
Entity	limited liability company Citizenship Delaware			
Address	345 South Douglas Street El Segundo, CA 90245 UNITED STATES			

Attorney informa-	Andrea J. Mealey
tion	Hinckley Allen & Snyder LLP
	28 State Street
	Boston, MA 02109
	UNITED STATES
	tmdocket@hinckleyallen.com Phone:617-345-9000

Applicant Information

Application No	86283418	Publication date	04/14/2015
Opposition Filing Date	04/15/2015	Opposition Period Ends	05/14/2015
Applicants	Cronin, Daniel Troy 67 Georgia St. Groton, CT 06340 UNITED STATES Vanessa Taborda Cronin 67 Georgia St. Groton, CT 06340 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Athletic pants; Athletic shirts

Grounds for Opposition

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3015294	Application Date	07/16/2004
Registration Date	11/15/2005	Foreign Priority Date	NONE
Word Mark	YOGITOES		

Design Mark	YOGITOES
Description of Mark	NONE
Goods/Services	Class 024. First use: First Use: 2003/08/01 First Use In Commerce: 2004/06/16 towels * used for fitness and exercise * [; textile fabrics used in the manufacture of towels and clothing]

U.S. Registration No.	3378733	Application Date	09/01/2006	
Registration Date	02/05/2008	Foreign Priority NONE Date		
Word Mark	YOGITOES			
Design Mark	yog	ito	es	
Description of Mark	"The mark consists of an orange coloredword yogitoes and an orange dot directly below the "it" portion of the word yogitoes."			
Goods/Services	Class 020. First use: First Use: 2003/08/01 First Use In Commerce: 2004/06/16			
	pillows and head supporting pillows used for fitness and exercise in the natureof yoga, Pilates and meditation			
	Class 024. First use: First Use: 2003/08/01 First Use In Commerce: 2004/06/16			
	towels used for fitness and exercise [; textile fabrics used in the manufacture of towels and clothing]			

Attachments	78452202#TMSN.png(bytes) 78965791#TMSN.png(bytes)
	Notice of Opposition YOGATO with Exhibits.pdf(223047 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

,	Signature	/Andrea J Mealey/	
П	Name	Andrea J. Mealey	
П	Date	04/15/2015	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the matter of: Date of Filing: Mark: Date of Publication:	Serial No. 86/283,418 May 16, 2014 YOGATO (Stylized) April 14, 2015			
Yogitoes, LLC, Opposer,)))	Opposition No.	
vs.)	•	
Vanessa Taborda Cro	onin DBA YogaTo)		
Daniel Troy Cronin I Applic	0)) _)		

UNITED STATES PATENT AND TRADEMARK OFFICE Trademark Trial and Appeal Board P.O. Box 1451 Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer, Yogitoes, LLC ("Opposer") is a limited liability company duly organized and existing under the laws of the State of Delaware, with a principal place of business at 345 South Douglas Street, El Segundo, California 90245.

Opposer believes it will be damaged by the registration of U.S. Trademark Application Serial No. 86/283,418 filed by Vanessa Taborda Cronin DBA YogaTo and Daniel Troy Cronin DBA YogaTo (collectively, "Applicant") for the mark YOGATO (Stylized) covering "athletic pants; athletic shirts," in Class 25 and hereby opposes the same.

As grounds in support for this opposition, Opposer alleges the following:

1. Opposer, through its predecessor in interest, adopted the term YOGITOES as a trademark for, and has consistently used YOGITOES as a trademark to identify, its specialized yoga and exercise towels, long before any date of first use upon which Applicant can rely.

- 2. Opposer has used the mark YOGITOES in interstate commerce in relation to its yoga and exercise towel products since at least as early as 2004.
 - 3. Opposer is the owner of the following United States Federal Registrations:

YOGITOES (and Design), Reg. No. 3378733 for pillows and head supporting pillows used for fitness and exercise in the nature of yoga, Pilates and meditation in Class 20, and towels used for fitness and exercise in Class 24; and

YOGITOES, Reg. No. 0084705 for towels used for fitness and exercise in Class 24.

Copies of TSDR Reports from the USPTO electronic records system showing the current status and current title for the foregoing registrations are attached as Exhibit 1.

- 4. During the over ten (10) years in which Opposer has made continuous use of the YOGITOES mark in connection with yoga and exercise towels, Opposer has expended considerable time, effort and resources in the advertisement, promotion, sale and distribution of products bearing the YOGITOES mark.
- As a result of Opposer's extensive and continuous use and promotion of its
 YOGITOES mark, the mark embodies substantial and valuable good will belonging exclusively to Opposer.
- 6. On May 16, 2015, Applicant filed an application for the mark YOGATO (Stylized for athletic pants and athletic shirts in Class 25, and this application was assigned Serial No. 86/283,418 by the United States Patent and Trademark Office.
- 7. The most prominent part of Applicant's applied for mark YOGATO (Stylized) is the word YOGATO.
- 8. The Applicant filed its application based on intent to use the mark YOGATO (Stylized) and to date has not amended the application to state a date of first use of the mark in commerce.

- 9. Opposer's rights in its YOGITOES mark are prior in time to the filing date of Applicant's intent to use application.
- 10. Opposer's rights in its YOGITOES mark are prior in time to any date of first use by Applicant for its YOGATO (Stylized) mark.
- 11. Opposer's Class 20 and 24 goods and Applicant's Class 24 goods are closely related.
- 12. Opposer's Class 20 and 24 goods and Applicant's Class 24 goods are identified in Opposer's Registrations and in Applicant's application as being for use for athletic activities.
- 13. Opposer's goods identified by its YOGITOES mark and Applicant's goods proposed to be identified by the YOGATO (Stylized) mark are targeted to persons engaged in athletic activities and are therefore likely going to be marketed and sold to overlapping consumers.
- 14. Opposer's goods to be identified by its YOGITOES mark and Applicant's goods proposed to be identified by the YOGATO (Stylized) mark are targeted to persons engaged in athletic activities and are therefore likely going to be marketed and sold through overlapping channels of trade.
- 15. Athletic apparel such as that of Applicant and athletic accessories such as those made by Opposer are often sold through the same outlets such as yoga studios and sporting goods stores and such products are often displayed in close proximity to one another.
- 16. Applicant's YOGATO (Stylized) mark is very similar to Opposer's YOGITOES mark.
- 17. The term YOGATO in Applicant's applied for mark is very similar to Opposer's mark YOGITOES.

- 18. Accordingly, the commercial impression of Applicant's YOGATO (Stylized) mark is very similar to the commercial impression created by Opposer's mark, YOGITOES.
- 19. The mark YOGATO (Stylized) so resembles Opposer's previously used and registered YOGITOES mark and creates such a similar commercial impression to Opposer's YOGITOES marks as to be likely, when applied to the goods set forth in Applicant's application, to cause confusion, mistake or deception within the meaning of Section 2(d) of the Trademark Act.
- 20. Given Opposer's federal registrations for YOGITOES for yoga and exercise towel products in Classes 24 and 20 respectively, conferring exclusive, nationwide rights to Applicant in the mark YOGATO would be improper and would interfere with Opposer's prior rights.
- 21. Use by Applicant of such YOGATO mark would also likely lead to the mistaken belief in the minds of consumers that Applicant's products originate with, are affiliated with or are sponsored or endorsed by Opposer.
- 22. Opposer will be damaged by the registration sought by the Applicant because such registration will support and assist Applicant in the confusing and misleading use of the YOGATO mark, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.
- 23. Registration of the YOGATO and Design mark therefore should be refused pursuant to Section 2(d) of the Trademark Act of 1946, as amended (15 U.S.C. §1052(d)), on the grounds that the Applicant's YOGATO mark so resembles Opposer's YOGITOES mark as to be likely when used on or in connection with the goods of Applicant to cause confusion or to cause mistake or to deceive, all to the detriment of Opposer.

WHEREFORE, Opposer asserts that it will be damaged by the registration of Applicant's mark YOGATO (Stylized), and prays that this Opposition be sustained and that registration of the YOGATO (Stylized) mark in Class 25 be refused.

Dated: April 15, 2015 Respectfully submitted,

YOGITOES, LLC,

/Andrea J Mealey/

Andrea J. Mealey
Janet E. Justmann
Attorneys for Opposer
Hinckley Allen & Snyder LLP
28 State Street
Boston, MA 02109

Phone: 617-345-9000 Fax: 617-345-9020

CERTIFICATE OF SERVICE

I hereby certify that on April 15, 2015, a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served upon the Applicants by overnight mail, postage prepaid, addressed as follows:

Vanessa Taborda Cronin DBA YogaTo Daniel Troy Cronin DBA YogaTo 67 Georgia St. Groton, Connecticut 06340

> By: /Andrea J Mealey/ Andrea J. Mealey

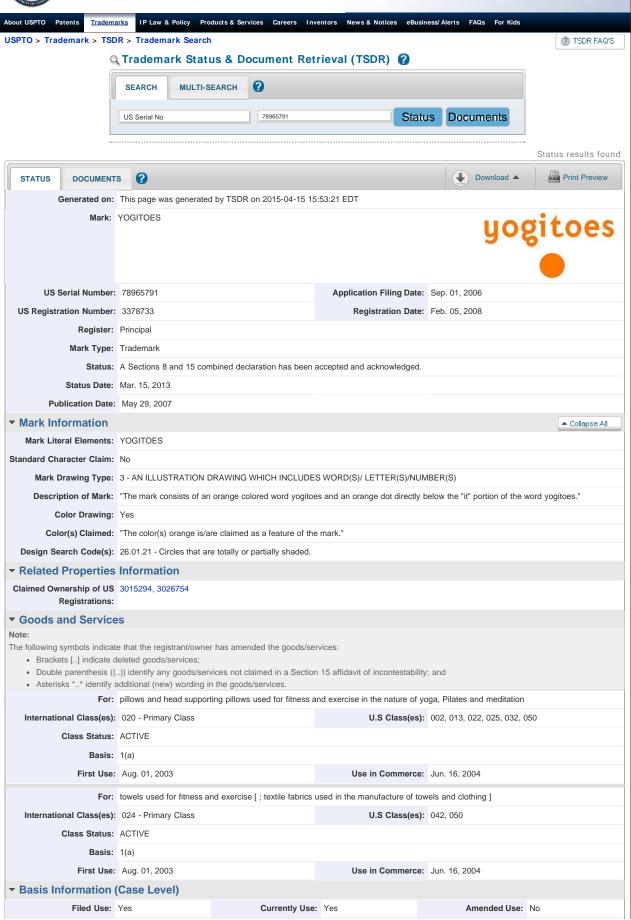
EXHIBIT 1



United States Patent and Trademark Office

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Trademark Status and Document Retrieval



 Filed ITU:
 No
 Currently ITU:
 No
 Amended ITU:
 No

 Filed 44D:
 No
 Currently 44D:
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 Amended 44D:
 No

 Filed 44E:
 No
 Currently 44E:
 No
 Amended 44E:
 No

 Filed 66A:
 No
 Currently 66A:
 No

▼ Current Owner(s) Information

Owner Name: YOGITOES LLC

Owner Address: 345 SOUTH DOUGLAS STREET

EL SEGUNDO, CALIFORNIA 90245

UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY State or Country Where DELAWARE

Organized:

▼ Attorney/Correspondence Information

Attorney of Record

Attorney Name: Deborah L. Benson

Correspondent

Correspondent Deborah L. Benson
Name/Address: Hinckley, Allen & Snyder LLP

28 State Street

BOSTON, MASSACHUSETTS 02019-1775

UNITED STATES

Phone: 617-345-9000 **Fax:** 617-345-9020

Correspondent e-mail: tmdocket@hinckleyallen.com

Correspondent e-mail: Yes

Authorized:

Domestic Representative - Not Found

▼ Prosecution History

1 Tooccation Thatory		
Date	Description	Proceeding Number
Nov. 20, 2013	SEC 7 REQUEST FILED	75184
Dec. 03, 2013	AMENDMENT UNDER SECTION 7 - ISSUED	75184
Dec. 03, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75184
Nov. 20, 2013	TEAS SECTION 7 REQUEST RECEIVED	
Jul. 17, 2013	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Mar. 15, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Mar. 15, 2013	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	66607
Mar. 15, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	66607
Feb. 28, 2013	TEAS SECTION 8 & 15 RECEIVED	
Aug. 27, 2008	CERTIFICATE OF CORRECTION ISSUED	
Aug. 27, 2008	ASSIGNED TO PARALEGAL	76293
Feb. 05, 2008	REGISTERED-PRINCIPAL REGISTER	
Jan. 02, 2008	OPPOSITION TERMINATED NO. 999999	180907
Jan. 02, 2008	OPPOSITION DISMISSED NO. 999999	180907
Dec. 13, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Dec. 13, 2007	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 26, 2007	OPPOSITION INSTITUTED NO. 999999	180907
Oct. 11, 2007	ASSIGNED TO EXAMINER	83178
Jun. 28, 2007	EXTENSION OF TIME TO OPPOSE RECEIVED	
May 29, 2007	PUBLISHED FOR OPPOSITION	
May 09, 2007	NOTICE OF PUBLICATION	
Mar. 31, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	76869
Mar. 03, 2007	ASSIGNED TO LIE	76869
Jan. 30, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 30, 2007	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jan. 29, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jan. 29, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	

Jan. 26, 2007		NON-FINAL ACTION E-MA	ILED 6	325
Jan. 26, 2007		NON-FINAL ACTION WRIT	TEN 7	6612
Jan. 26, 2007		ASSIGNED TO EXAMINER	7	6612
Sep. 08, 2006		NOTICE OF DESIGN SEAF MARK MAILED	RCH CODE AND PSEUDO	
Sep. 07, 2006		NEW APPLICATION ENTER	RED IN TRAM	
▼ Maintenance Filing	s or Post Registra	tion Information		
Affidavit of Continued Use:	Section 8 - Accepted			
Affidavit of Incontestability:	Section 15 - Accepted			
Change in Registration:	Yes			
Amendment to a Registration/Renewal Certificate:				
	. ,	line 7 "used for fitness and eused for fitness and exercise		Pilates and meditation" should be inserted. column
▼ TM Staff and Location Information				
TM Staff Information - None				
File Location				
Current Location:	TMO LAW OFFICE 115		Date in Location:	Dec. 03, 2013
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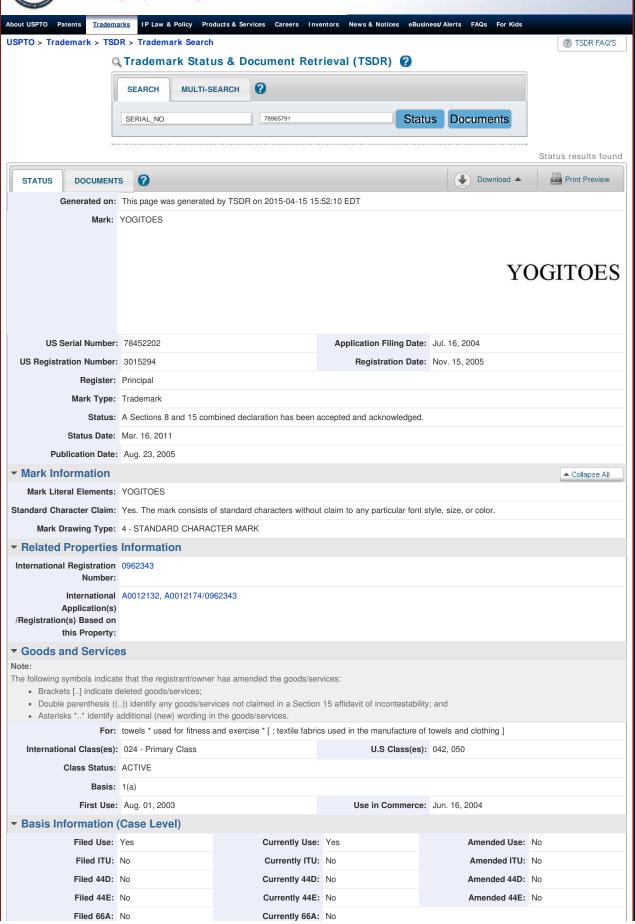
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Trademark Status and Document Retrieval



Filed No Basis: No Currently No Basis: No ▼ Current Owner(s) Information Owner Name: YOGITOES LLC Owner Address: 345 SOUTH DOUGLAS STREET EL SEGUNDO, CALIFORNIA 90245 UNITED STATES Legal Entity Type: LIMITED LIABILITY COMPANY State or Country Where DELAWARE Organized: Attorney/Correspondence Information Attorney of Record Attorney Name: Deborah L. Benson Docket Number: 068804/01582 Attorney Primary Email jpbroder@san.rr.com Attorney Email Authorized: Yes Address: Correspondent Correspondent Deborah L. Benson Name/Address: Hinckley, Allen & Snyder LLP 28 State Street BOSTON, MASSACHUSETTS 02109-1775 **UNITED STATES** Phone: 858-635-2142 Fax: 858-635-9686 Correspondent e-mail: jpbroder@san.rr.com Correspondent e-mail Yes Authorized: **Domestic Representative - Not Found** Prosecution History Date Description **Proceeding Number** AMENDMENT UNDER SECTION 7 - ISSUED Dec. 03, 2013 76293 Nov. 20. 2013 SEC 7 REQUEST FILED 76293 Dec. 03, 2013 CASE ASSIGNED TO POST REGISTRATION 76293 PARALEGAL TEAS SECTION 7 REQUEST RECEIVED Nov. 20, 2013 AUTOMATIC UPDATE OF ASSIGNMENT OF Jul. 17, 2013 Mar. 16, 2011 REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 68335 15 ACK Mar 16 2011 CASE ASSIGNED TO POST REGISTRATION 68335 PARALEGAL Feb. 28, 2011 TEAS SECTION 8 & 15 RECEIVED Mar. 20, 2008 AMENDMENT UNDER SECTION 7 - ISSUED Feb. 29, 2008 ASSIGNED TO PARALEGAL 61619 Dec. 13, 2007 TEAS SECTION 7 REQUEST RECEIVED Nov. 15, 2005 REGISTERED-PRINCIPAL REGISTER PUBLISHED FOR OPPOSITION Aug. 23, 2005 Aug. 03, 2005 NOTICE OF PUBLICATION May 02, 2005 LAW OFFICE PUBLICATION REVIEW COMPLETED Apr. 29, 2005 ASSIGNED TO LIE 71466 Apr. 28, 2005 APPROVED FOR PUB - PRINCIPAL REGISTER Mar. 30, 2005 AMENDMENT FROM APPLICANT ENTERED 71466 Mar. 17, 2005 CORRESPONDENCE RECEIVED IN LAW OFFICE 71466 Mar. 17, 2005 TEAS RESPONSE TO OFFICE ACTION RECEIVED Mar. 17, 2005 TEAS CHANGE OF CORRESPONDENCE RECEIVED Feb. 22, 2005 NON-FINAL ACTION E-MAILED 6325 Feb. 22, 2005 NON-FINAL ACTION WRITTEN 76613 Feb. 18, 2005 ASSIGNED TO EXAMINER 76613 Jul 27 2004 NEW APPLICATION ENTERED IN TRAM ▼ Maintenance Filings or Post Registration Information Affidavit of Continued Section 8 - Accepted Use: Affidavit of Section 15 - Accepted

Incontestability:

Change in Registration:

Amendment to a Registration/Renewal Textile fabrics used in the manufacture of towels and clothing" is deleted.

Certificate:

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location:

POST REGISTRATION

Date in Location:

Dec. 03, 2013

Assignment Abstract Of Title Information - Click to Load

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